

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

IMPINJ, INC.,

Plaintiff,

v.

NXP USA, INC.,

Defendant.

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No. 6:21-cv-00530-ADA

Patent Case

Jury Trial Demanded

CASE READINESS STATUS REPORT

Plaintiff Impinj, Inc. (“Impinj”) and Defendant NXP USA, Inc. (“NXP”), hereby provide the following status report.

FILING AND EXTENSIONS

Impinj’s Original Complaint was filed on May 25, 2021. (Dkt. 1.) Impinj’s First Amended Complaint was filed on June 10, 2021. (Dkt. 8.) Impinj’s First Amended Complaint accuses NXP of infringing nine (9) patents. (Id.) NXP received a thirty (30) day extension of time to respond to Impinj’s First Amended Complaint. (Dkt. 11.)

RESPONSE TO THE COMPLAINT

NXP filed its Answer, Affirmative Defenses and Counterclaims to Impinj’s First Amended Complaint on July 26, 2021. (Dkt. 15.) NXP’s Counterclaims accuse Impinj of infringing nine (9) patents. NXP alleges that it is the owner of the one of the patents and the exclusive licensee of the remaining patents.

PENDING MOTIONS

There are no pending motions.

RELATED CASES IN THIS JUDICIAL DISTRICT

There are no related cases in this judicial district. The parties have asserted infringement against each other in two other districts. Impinj sued NXP for alleged infringement in the Northern District of California on June 6, 2019 (*Impinj, Inc. v. NXP USA, Inc.*, Case No. 4:19-cv-03161-YGR (N.D. Cal.)), and NXP sued Impinj for infringement on October 4, 2019, in a case now pending in the Western District of Washington (*NXP USA, Inc. et al. v. Impinj, Inc.*, Case No. 2:20-cv-01503-RSM-KSV (W.D. Wash.)).

IPR, CBM, and OTHER PGR FILINGS

There are no known IPR, CBM, or other PGR filings for the patents asserted in this action.

NUMBER OF ASSERTED PATENTS AND CLAIMS

Impinj has asserted nine (9) patents and a total of twenty-five (25) claims. The Asserted Patents are U.S. Patent Nos. 7,246,751; 7,116,240; 7,388,468; 7,215,251; 8,665,074; 7,472,835; 7,733,227; 10,776,198; and 10,929,734.

The Case Management Conference is deemed to occur fourteen (14) days after the filing date of this Case Readiness Status Report. (Dkt. 10.) Pursuant to the Court's Order Governing Proceedings—Patent Case, Impinj will serve its Preliminary Infringement Contentions on NXP no later than seven (7) days before the Case Management Conference. (*Id.*)

NXP has asserted nine (9) patents and a total of nine (9) exemplary claims. The Asserted Counterclaim Patents are U.S. Patent Nos. 7,586,385; 8,081,043; 9,825,608; 9,830,548; 9,991,596; 10,210,358; 10,637,443; 10,789,433; and 8,970,285. NXP will serve its Preliminary Infringement Contentions on Impinj no later than seven (7) days before the Case Management Conference.

APPOINTMENT OF TECHNICAL ADVISOR

The parties do not object to a technical adviser being appointed to this case to the extent the Court believes it would assist with claim construction or other issues.

MEET AND CONFER STATUS

Impinj and NXP have met and conferred. The parties identified the following pre-*Markman* issues to raise at the CMC:

Impinj's Statement of Pre-*Markman* Issues to Raise at the CMC

Impinj anticipates filing a motion to sever and/or a motion to have the parties' claims proceed on different tracks based, in large part, on claims and assertions made in the other cases between the parties. Impinj also reserves the right to seek to require that the owner of the eight (8) licensed patents be added as a necessary or indispensable party. Impinj will meet and confer with NXP regarding a due date for its preliminary invalidity contentions to the asserted patent counterclaims.

NXP's Statement of Pre-*Markman* Issues to Raise at the CMC

If Impinj files a motion to sever and/or a motion to have the parties' claims proceed on different tracks, NXP will oppose such motions on the merits. This case will be resolved most efficiently and expeditiously if each party's claims proceed on the same schedule, as is typical in patent litigation.

Respectfully submitted August 2, 2021.

/s/ Jose C. Villarreal

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 2, 2021, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system.

/s/ Jose C. Villarreal

Jose C. Villarreal